

Application No. 09/846,632
Amendment dated July 21, 2008
Reply to Final Office Action of May 19, 2008

REMARKS/ARGUMENTS

Applicant has reviewed and considered the Final Office Action mailed on May 19, 2008, and the references cited therewith.

No claims are amended, no claims are presently cancelled or added (claims 5, 7, 8 and 17 were previously cancelled); as a result, claims 1-4, 6, 9-16 and 18-25 are now pending in this application.

Application to be Considered "Special"

MPEP 707.02 requires any application up for a third action, or has been pending five years, is to be considered "special" by the examiner.

The present application was filed 05/01/2001, more than five years ago. This application may also be up for a third action in view of the remarks made below with respect to the second action being prematurely made final. Therefore, Applicant respectfully requests this application be considered "special" so as to receive examination priority, as well as participation of the supervisory patent examiner in the examination of this application, as set forth in MPEP 707.02.

Final Rejection Premature

The Office Action Summary, mailed 05/19/2008, indicates it is a FINAL action. The Disposition of Claims indicates that claims 22 and 25 are both pending in the application, and rejected. However, no statement of grounds for the rejection of claims 22 and 25 is made in the Detailed Action. In particular, Applicant has not been apprised as to the statutory basis for the ground of rejection of claims 22 and 25. Nor does the present rejection of these claims refer to a single previous Office Action containing a complete statement of a ground of rejection for either of claims 22 and 25 (*see* MPEP 707.07 *et al.*).

37 CFR 1.104 (b) requires an examiner's action to be complete as to all matters, with all requirements outstanding in an application being noted in every action. Each claim should be mentioned in each Office Action and its treatment or status given, including a statement when claims are allowable. From Applicant's review of the file history, no clear issue has ever been developed between the Examiner and Applicant with respect to claims

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22 and 25. Applicant is entitled to readily judge the advisability of an appeal of these claims (*see also* MPEP 706.07).

As such, Applicant respectfully submits that the final rejection of claims 22 and 25 is premature, as claims 22 and 25 have not had a complete and proper first, or second, action on the merits. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the finality of the Office Action mailed 05/19/2008.

§103 Rejection of the Claims

Claims 1, 2, 9, 12, 13, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827) and Moraw et al. (U.S. Pat. No. 4,324,421).

Claims 3 was rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey (U.S. Pat. No. 5,342,672).

Claims 4, 6, 10, 11, 14-16, and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of McConville et al. (U.S. Pat. No. 4,968,063).

Claim 18 was rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al. as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey and McConville et al.

Applicant respectfully traverses these rejections as follows.

Independent claim 1 is directed to a transparent data sheet. According to claim 1, two transparent layers are laminated together to form a resulting transparent data sheet. If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is "necessary to give life, meaning and vitality" to the claim, then the claim preamble should be construed as if in the balance of the claim. M.P.E.P. § 2111.02. The final Office Action effectively ignores the context of the present invention provided by the preamble.

The primary reference cited against the present application is the Stephens reference. Page 2 of the Office Action mailed May 19, 2008 suggests that the Stephens reference

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"inherently teaches . . . substantially all of the subject matter set forth in the claims except for the claims layer materials and indicia on one of its transparent layers." The Stephens reference is directed to a folded information card sealed within a clear plastic envelope. The information card is opaque such that information contained thereon will be shielded against outward view when folded and secured in the plastic envelope.

First, the Stephens reference does not appear to teach or suggest a transparent data sheet. Applicant respectfully submits that, in fact, the Stephens reference *teaches away* from a transparent data sheet. That is, the Stephens reference appears to describe a data sheet that is intentionally non-transparent. The non-transparency characteristics are utilized to secure, e.g., hide, recorded data from view. Applicant respectfully submits that it is the principle objective of the Stephens reference to not provide a transparent data sheet.

Such teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is *per se* demonstration of lack of obviousness. See e.g., In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988); In re Beattie, 974 F.2d 1309, 24 U.S.P.Q.2d 1040 (Fed. Cir. 1992); Gillette Co. v. S.C. Johnson & Sons, 919 F.2d 720, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990).

Neither of the other cited references, the Smith reference or the Moraw reference, cure the deficiency in the Stephens reference. From Applicant's review, the Smith reference describes a window badge having a see-through panel adhered to a substrate of rigid plastic material. The Smith reference does not teach the plastic substrate being transparent, and Figure 2 of the Smith reference does not appear to show that the substrate is transparent, since the indicia is not visible from the rear view of the name badge.

From Applicant's review, the Moraw reference describes an identity card with incorporated fibrils. The identity card appears to be formed of a thermoplastic core layer covered by a transparent outer layer. The core layer is described as preferably being paper felt with added polyolefin fibers (column 3, lines 28-37), with polyethylene fibers and/or pigments optionally mixed in (column 3, lines 42-44). Figure 4 shows the core layer being non-transparent, by the holes of the reinforcing layer not being visible through the core

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layer. Thus, neither of the Smith reference or the Moraw reference appears to modify the non-transparent data sheet described in the Stephens reference.

Secondly, Applicant respectfully submits that the Office Action mailed May 19, 2008 does not establish a *prima facie* case of obviousness. Specifically, the Office Action asserts that the Stephens reference "teaches . . . substantially all of the subject matter set forth in the claims" with two exceptions (for which additional references are cited as teaching). To establish a *prima facie* case of obviousness references must teach or suggest all the claim limitations. M.P.E.P. § 2143.03. Applicant respectfully submits that even if the combined Stephens, Smith and Moraw references were to teach substantially all of the subject matter set forth in the claims, such teachings would not establish a *prima facie* case of obviousness, as required.

Third, the Office Action mailed May 19, 2008 suggests that the Stephens reference "inherently teaches . . . substantially all of the subject matter set forth in the claims" with two exceptions (for which additional references are cited as teaching). The Office Action only asserts un-specifically that the claimed structure is disclosed by the Stephens reference, which is insufficient as a matter of law to support the claimed transparent data sheet. Not only do the Examiner's alleged inherent characteristics not necessarily flow from the teachings of the cited prior art, they are directly contrary to the clear and unambiguous teachings of the cited reference itself, e.g., the Stephens reference teaches a non-transparent data sheet. Such allegations, unsupported by any evidence, and in fact contradicted within the reference, are improper. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness, by inherency or otherwise,

Fourth, Office Action further suggests that it "would have been obvious to a skilled artisan at the time the invention was made to provide Stephens with indicia (overt or covert) on one of its transparent layers in the manner as taught by Smith in order to provide more information to the user." However, the Smith reference describes a name badge. Applicant respectfully submits that the Smith reference does not teach or suggest a transparent layer having covert security features. And independent claim 1 includes the limitation of overt and covert security features. Furthermore, the Smith reference does not teach or suggest a transparent fragile layer including the overt and covert security features, where two

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transparent layers are laminated together. And finally, Applicant respectfully submits that the suggested motivation ("to provide more information to the user") is an inconsistent motivation for one skilled in the art to look to the Smith reference from the Stephens reference for including covert security features.

In the Response to Arguments section of the Office Action, the Examiner suggests that "the choice of overt and/or covert indicia would have been obvious to one having ordinary skill in the art at the time the invention was made" "since it would only depend on the intended use of the assembly and the desired information to be displayed." However, this reasoning is misplaced, as independent claim 1 includes the limitation of "the transparent fragile layer includes overt and covert security features" and the Smith reference does not teach or suggest covert security features by describing name badge indicia printed onto a rear surface of a clear panel.

Additionally in the Response to Arguments section of the Office Action, the Examiner asserts that "it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability," but offers no authority for the purported assertion. Applicant respectfully contests the Examiner's above assertion as being unsupported by a properly cited authority, and respectfully submits that nevertheless it is immaterial since the claimed overt and covert security features are, by definition, functionally related to the security of the transparent fragile layer as set forth in the claimed limitations ("where the two layers are laminated together and at least one of the overt and covert security features of the transparent fragile layer is detectibly damaged after an attempt to tamper with the transparent data sheet").

Finally, Stephens describes sealing a folded paper blank inside a transparent plastic envelope to secure the card against outward view and against unauthorized removal of the card without breaching the sealed integrity of the envelope. The Office Action suggests that that it would have been obvious to one skilled in the art to achieve a fragile and a durable layer in the manner suggested by the Moraw reference in order to enhance the durability of the assembly. However, in the lamination described in the Stephens reference, two plastic plies are used to form the two side of an envelope around the card. One ply does not protect

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the other. And applicant respectfully submits that one skilled in the art would not form a protective envelope with a fragile ply on one side and a durable ply on the other. The Examiner is merely using the present disclosure in impermissible hindsight as a blueprint to arrive at the claimed invention.

For all of the above-mentioned reasons, Applicant respectfully submits that the Stephens, Smith and Moraw references, either individually or in combination, do not teach, suggest, or make obvious each and every element and limitation of independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection of independent claim 1, as well as claims 2-4, 6, 9-16, 18-22 and 25 that depend therefrom.

With particular respect to the dependent claims, Applicant respectfully submits that the Office Action does not allege, nor does the Stephens reference appear to teach or suggest the additional limitations of the dependent claims, including: the transparent fragile layer is a multilayered polyurethane film (claim 9); the thermoplastic transparent durable layer is a multilayer optical film (claim 10); the multilayer optical film is comprised of at least one material that exhibits stress induced birefringence (claim 11); the transparent fragile layer is comprised of more than one fragile material (claim 13); the thermoplastic transparent durable layer is comprised of one or more durable layers (claim 14); at least one of the overt and covert security features are visible from both major surfaces of the transparent data sheet (claim 15); the thermoplastic transparent durable layer is a multilayer optical film (claim 16); a layer of hot melt adhesive on one of the transparent fragile layer and the thermoplastic transparent durable layer that can not be re-used without evidence of tampering (claim 19); and a passport, wherein the transparent data sheet is inserted or otherwise attached to the passport (claim 20). As such, the Office Action fails to establish a *prima facie* case of obviousness as to the above-mentioned dependent claims with respect to the Stephens reference (the Office Action merely generically asserts the Stephens reference teaches the above-mentioned subject matter without pointing to any support within the Stephens reference).

Nor do the other cited references appear to cure the defects in the Stephens reference with respect to claims 9-11, 13-16, 19 and 20. Thus, the cited references do not teach,

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suggest, or make obvious each and every element and limitation of claims 9-11, 13-16, 19 and 20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection of each of dependent claims 9-11, 13-16, 19 and 20.

Independent claims 23 and 24 are directed to a process for manufacturing a transparent data sheet. For all the reasons set forth above with respect to independent claim 1, Applicant respectfully submits that the Stephens, Smith and Moraw references do not teach or suggest a transparent data sheet, and therefore cannot teach or suggest the manufacture thereof. As such, Applicant respectfully submits that the Stephens, Smith and Moraw references, either individually or in combination, do not teach, suggest, or make obvious each and every element and limitation of independent claims 23 and 24. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection of independent claims 23 and 24.

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CONCLUSION

Applicant submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

The Examiner is invited to telephone the applicant's below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

July 21, 2008
Date

By: 

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